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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/811,844

03/19/2001

Louis Peter Huber

P04870US0

9248

22885

7590

08/19/2005

MCKEE, VOORHEES & SEASE, P.L.C.

801 GRAND AVENUE

SUITE 3200

DES MOINES, IA 50309-2721

EXAMINER

EASTHOM, KARL D

ART UNIT

PAPER NUMBER

2832

DATE MAILED: 08/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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**Office Action Summary**

Application No.

09/811,844

Applicant(s)

HUBER ET AL.

Examiner

Karl D. Easthom

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 July 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3, 9-12, 16-18.20.22-25,30 and 31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) i is/are allowed.
- 6) ☒ Claim(s) 1-3, 9-12, 16-18.20.22-25,30 and 31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 30-31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is not clear how one can "[separate] the ..resistors with the glass frit" since no glass frit is claimed.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 30 and 31 are rejected under 35 U.S.C. 102(b) as anticipated by JP 628301 or, in the alternative, under 35 U.S.C. 103(a) as obvious over JP 628301 in view of Chiang 99/53505. JP '301 discloses, the claimed invention at Figs. 1 or Fig. 6c with first and second film resistors implied at par. 1 as two devices stacked in general, where one is explicitly described at par. 8, with end caps 11b and 11c, barriers 13, and encapsulant depicted therebetween as the rectangular cover implied since pars. 8-9 disclose that the film part of the resistor is not depicted; i.e., it is within or under the rectangular encapsulant depicted. Moreover, and for claim 31, the covering part depicted must be a dielectric covering thereof, or inert encapsulant, as implied and depicted since any other type of material other than a dielectric or inert encapsulant would destroy the function of the resistor. JP' 301 suggests elements 31,32,33 can all be film resistors of the same type, where different types of chips that are the same size are stacked together to

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save space, and since two or more chip elements in general are disclosed as stacked at par. .

Further, applicant admits at pages 1-2 that the resistors of the same type have been stacked as is known to increase capacity. The adhesives noted on page 2 of the machine translation are noted as “desirable” hence, it is contemplated that they will not be used. . The product by process limitation of separating and joining added with the recent 7/12/5 amendment does not render the product distinct since there is no structural distinction created by such a process either argued, alleged or factually based otherwise.

4. As to the 103 alternative, where the encapsulant implied as noted above and the two resistors stacked as noted above are not explicit enough to meet the 35 USC 102 requirements, or glass frit is required for the encapsulant, the chips of Chiang are stacked as noted at the abstract, and the resistors can be the same or different, with an encapsulant 53 disclosed to separate the devices. Chiang discloses that any insulator is useful for aids in stacking chip, at page 11, lines 29-36, and page 10, lines 18-25, so that an inert glass frit or any encapsulant would have been obvious. While the glass frit encapsulant is not claimed or inferentially claimed, the Examiner takes Official Notice that glass is a well known electrical insulator, see The Random House College Dictionary (revised 1980), as proof therefor, defining insulator as “a material of low conductivity, as glass or porcelain..”, so that it would have been obvious to employ a glass where a frit glass is simply a type of glass. Or glass is a glass frit, where frit is the fused materials used in glass making according to Webster's II New Riverside University Dictionary. See also Holmes which uses glass frit, glaze and glass interchangeably, using a lead borosilicate glass at page 139 as the glass frit. The adhesives noted on page 2 of the machine translation are noted as “desirable” hence, it is contemplated that they will not be used. Also, Chiang discloses

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as noted on page 10 that the insulating member need not be an adhesive so that it would have been obvious not to employ one where bonding is obtained by other means. For further motivation, multiple chips are contemplated page 12 of Chiang or Fig. 6 of JP'301 rendering same obvious for the purpose of saving space or lowering resistance as suggested by Chiang at page 1, lines 30-35. Finally, applicant admits at pages 1-2 that it is known to stack like resistors to provide more capacity.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 6283301 in view of Chiang 99/53505. JP '301 discloses, except the nickel barrier, frit encapsulant, and inert encapsulant, the claimed invention at Fig. 6c with first and second film resistors implied at par. 1 as two devices stacked in general, where one is explicitly described at par. 8, with end caps 11b and 11c, barriers 13, and an encapsulant therebetween as noted above. JP' 301 discloses, suggests or implies that elements 31,32,33 can all be film resistors of the same type, where different types of chips that are the same size are stacked together to save space, and since two or more chip elements in general are disclosed as stacked at par. 1. Further, applicant admits at pages 1-2 that the resistors of the same type have been stacked as is known to increase capacity. Finally, the chips of Chiang are stacked as noted at the abstract, and the resistors can be the same or different. Chiang discloses that any insulator and that any metal barriers are useful for aids in stacking chip, at page 11, lines 29-36, and page 10, lines 18-25, so that an inert

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encapsulant would have been obvious, such as glass for example (inert as noted by applicant in his specification), while nickel plating is disclosed as a useful conductor for the chips at page 6, so that it would have been obvious to use the well known nickel since any metal is suggested and nickel is listed as a conductive metal. The Examiner takes Official Notice that glass is a well known electrical insulator, see The Random House College Dictionary (revised 1980), as proof therefor, defining insulator as "a material of low conductivity, as glass or porcelain..", so that it would have been obvious to employ a glass where a frit glass is simply a type of glass. Or glass is a glass frit, where frit is the fused materials used in glass making according to Webster's II New Riverside University Dictionary. See also Holmes which uses glass frit, glaze and glass interchangeably, using a lead borosilicate glass at page 139 as the glass frit. The adhesives noted on page 2 of the machine translation are noted as "desirable" hence, it is contemplated that they will not be used. Also, Chiang discloses as noted on page 10 that the insulating member need not be an adhesive so that it would have been obvious not to employ one where bonding is obtained by other means. For further motivation, multiple chips are contemplated page 12 of Chiang or Fig. 6 of JP'301 rendering same obvious for the purpose of saving space or lowering resistance as suggested by Chiang at page 1, lines 30-35. The nickel barriers provide the stability and resistance to heating, because they are made of the same material as claimed, as modified, and further the elements are terms of degree. Similar remarks apply to the resistor being flow solderable since the same materials must have the same functions. The product by process limitation of separating and joining added with the recent 7/12/5 amendment does not render the product distinct since there is no structural distinction created by such a process either argued, alleged or factually based otherwise.

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7. Claims 2-3, 9-12, 16-18, 20, 22, and 24-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 6283301 in view of Chiang 99/53505, further in view of Hashimoto. The invention is disclosed as noted except the material of the resistor being ruthenium, and the end caps of nickel surrounding the end caps. Hashimoto discloses resistor chips such as that of JP '301 of a known resistive layer material of ruthenium with end covered by nickel barriers 9a known for the purpose of having good solderability or for protecting the underlying noble metal so that it would have been obvious to plate the end caps of JP '301 where solder plating is disclosed at par. 9. Further, applicant admits at pages 1-2 that the resistors of the same type have been stacked as is known to increase capacity. As to claim 1, Hashimoto also discloses the chip covered in glass 7 so that it would have added more motivation to that above to employ glass with the well known resistor. For further motivation and for claims 16-17 and 24-25, multiple chips are contemplated page 12 of Chiang or Fig. 6 of JP'301 rendering same obvious for the purpose of saving space or lowering resistance as suggested by Chiang at page 1, lines 30-35. For claims 10-11, since any metal can be used for the barrier, an alloy would have been obvious since alloys are known conductors. For claim 22, par. 8 of JP /301 discloses silver as the end cap

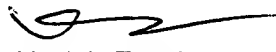
8. Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over JP 6283301 in view of Chiang 99/53505 and Hashimoto, further in view of Nakamura et al. The invention is disclosed as noted above except the silver palladium. That composition is a known electrode for ruthenium resistors as disclosed by Nakamura, such that it would have been obvious to employ it for the electrodes of JP '301 as modified.

9. Applicant's arguments filed 7/125/05 have been fully considered but they are persuasive. The product by process limitation of separating and joining added with the recent 7/12/5 amendment does not render the product distinct since there is no structural distinction created by such a process as can be determined by the examiner, nor is same either argued, alleged or factually based otherwise.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karl D Easthom whose telephone number is (571) 272-1989. The examiner can normally be reached on M-Th, 5:30AM-4:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Elvin Enad can be reached on (571) 272-1990. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Karl D Easthom  
Primary Examiner  
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